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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,827	10/19/2001	Ken Chow	17349CIP	. 9534
75	90 10/07/2005		EXAMINER	
Carlos A. Fisher ALLERGAN, INC.		·	FAY, ZOHREH A	
T2-7H			ART UNIT	PAPER NUMBER
2525 Dupont Drive			1618	
Irvine, CA 92	612		DATE MAILED: 10/07/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

		YI	
	Application No.	Applicant(s)	
Office Action Summan	10/039,827	CHOW ET AL.	
Office Action Summary	Examiner	Art Unit	•
	Zohreh A. Fay	1618	
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address	<u>.</u>
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period v.  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be timused and will expire SIX (6) MONTHS from a cause the application to become ABANDONE.	i. the mailing date of this communication. D (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on  2a) This action is FINAL. 2b) This  3) Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final.		
Disposition of Claims		,	
4) ☐ Claim(s) 1-6 is/are pending in the application.  4a) Of the above claim(s) is/are withdraw  5) ☐ Claim(s) is/are allowed.  6) ☐ Claim(s) is/are rejected.  7) ☐ Claim(s) is/are objected to.  8) ☐ Claim(s) 1-6 are subject to restriction and/or ele  Application Papers  9) ☐ The specification is objected to by the Examine 10) ☐ The drawing(s) filed on is/are: a) ☐ access applicant may not request that any objection to the objected to application to applicati	ection requirement.  r. epted or b) objected to by the Edrawing(s) be held in abeyance. See	e 37 CFR 1.85(a).	
11) The oath or declaration is objected to by the Ex	•		
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureau * See the attached detailed Office action for a list of	s have been received. s have been received in Application ity documents have been receive I (PCT Rule 17.2(a)).	on No ed in this National Stage	
Attachment(s)			
Notice of References Cited (PTO-892)   Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary Paper No(s)/Mail Da	(PTO-413)	
B) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date		atent Application (PTO-152)	

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## **DETAILED ACTION**

## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-3, drawn to a compound and composition, classified in class
   514, subclass 607.
- Claims 4-6, drawn to a method of using such composition for treating glaucoma, classified in class 514, subclass 607.

The inventions are distinct, each from the other because of the following reasons:

Inventions group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance,

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whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh A. Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Z.F

ZOHREH FAY
P RIMARY EXAMINER
GROUP 1200